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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/364,638	07/30/1999	EIJI KAWAI	450127-02126	9709

20999 7590 05/23/2003

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NEW YORK, NY 10151

EXAMINER

PEYTON, TAMMARA R

ART UNIT	PAPER NUMBER
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2182

DATE MAILED: 05/23/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicati n No.

09/364,638

Applicant(s)

KAWAI, EIJI

Examiner

Tammara R Peyton

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 21-23, 25-33 and 35-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-23, 25-33, 35-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 21-23, 25-33, and 35-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Roskowski et al.*, patent number 5,624,316.
2. As per claims 21, 23, 31, and 33, *Roskowski* teaches an information processing apparatus (Fig.1) comprising:
  - a processor (CPU, 33, Fig.2) for executing a booting program to start up said information apparatus; and
  - a data store for storing first data (ROM, 20, Fig.2),
  - wherein said processor selectively uses said first data stored in said data store or second data stored in another data store (ROM, 28, Fig.2) according to said booting program to start up said information processing apparatus, said other data store being removably connected (via smart card, 45, coupled to enhancer, 4, Figs. 1, 2) to said information processing apparatus;

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- whereby said other data store comprises a file allocation table block operable to store header information, a startup image display program storage block operable to act as a read only memory, and a data block operable to store data generated by said information processing apparatus.

3. *Roskowski* teaches wherein said processor executes a boot program from either a first data store, from an existing game cartridge, 1, Figs. 1, 2, or a second data store, from ROM, 28 implement in the enhancer 4. The enhancer is also able to accommodate a smart card, 15, which contain additional data. (Figs. 1, 2) The removable smart card/enhancer combined or just the enhancer contains a booting program to start up said information processing apparatus. It would have been obvious to one of ordinary skill that *Roskowski* teaches that depending on an enabled/disabled switch (44, Fig.1) said processor would selectively boot a start up program from either a first data store (ROM, 20) or second data store (smart card/enhancer) wherein the second data store is removable. (Abstract, col. 5, lines 25-65, col. 6, lines 1-65, col. 8, lines 45-col.9, lines 1-4, col. 12, lines 58-col. 13, lines 1-17).

4. *Roskowski* teaches the enhancer 4 including a startup image display (startup boot image) operable to act as a ROM (col. 5, lines 25-32 and 39-46). The start up image display disclosed by *Roskowski* may be read from internal ROM 28 or smart card 15. *Roskowski* further teaches a data block (RAM 27, col. 5, lines 33-46) operable to

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store data generated by said information processing apparatus (7, Fig. 1) wherein the information stored is from user input. However, *Roskowski* does not expressly teach a file allocation table, however, it is well known in the art that a file allocation table organizes and manages data on a storage device (i.e. floppy disk, memory or smart card) in such a way that when an accessing device (operating system, CPU) requests the stored data, the file allocation table directs the accessing device to the requested stored file on the storage device. *Roskowski* specifically teaches the enhancer 4 accessing and retrieving information from the smart card. (col. 5, lines 39-46)

5. Therefore, it is the position of the Examiner that it would have been obvious to one of ordinary skill that *Roskowski's* enhancer 4 has the characteristics consistent with a file allocation table because *Roskowski* teaches the enhancer accessing information stored on the smart card. One of ordinary skill would recognize that some form of file allocation table would be used to access the data stored on the smart card.

6. As per claim 27 and 37, *Roskowski* teaches a control logic for a) detecting an access to a patch address by the processor; b) logic for directing the processor to access an exception region in the second memory upon detection of the access to the patch address and; c) redirection logic for redirecting memory accesses by the processor from the first memory to the second memory for a plurality of memory access upon activation of the exception mode and redirecting memory accesses by the processor from the second memory to the first memory upon termination of the

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exception mode. Therefore, it would have been obvious to one of ordinary skill at the time the invention was made that *Roskowski* teaches the logic of an establishing data communication with a plurality of data stores for storing data. *Roskowski* also teaches an apparatus and method including a file allocation table block with a startup image display program and a data block. (see paragraph 5)

7. As per claims 22, 28, 30, 32, 38, and 40, *Roskowski* teaches wherein said information processing apparatus further comprises a display, and said first data (from cartridge 1) and said second data store (smart card/ enhancer) are image data, (as it related to a particular video game), and wherein said processor selectively/sequentially displays an image from said first data or an image of said second data said display according to said booting program in starting up said information processing apparatus. (as it relates to a particular video game inserted in the information processing apparatus)

8. As per claims 25 and 35, *Roskowski* teaches wherein said processor displays an image of said first data (from cartridge 1) on said display in starting up said information processing apparatus when said recording medium (smart card/ enhancer) is not connected to said information processing apparatus, and said processor displays an image of said second data on said display in starting up said information processing

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apparatus when said recording medium is connected to said information processing apparatus. (col. 5, lines 25-65)

9. As per claims 26, 29, 36, and 39, *Roskowski* teaches wherein said second data is a portable electronic device removably connected to said information processing apparatus.

10. Claims 21, 23, 27, 31, 33, 36, and 37, are rejected under 35 U.S.C. 103(a) as being unpatentable over *James, Jr. et al.*, (US 6,240,519).

11. As per claims 21, 23, 31, 33, and 36, *James, Jr.* teaches an information processing apparatus (computer) comprising:

- a processor (32, Fig. 2) for executing a booting program to start up said information apparatus (Fig.1); and
- a data store for storing first data (ROM, 78, Fig.2),
- wherein said processor selectively uses said first data stored in said data store or second data stored in another data store (Floppy Disk, 74, Fig.1) according to said booting program to start up said information processing apparatus, said other data store being removable connected (disk in Floppy Drive) to said information processing apparatus;
- whereby said other data store (floppy disk, 74) comprises a file allocation table block operable to store header information, a startup image display

program storage block operable to act as a read only memory, and a data block operable to store data generated by said information processing apparatus. (col. 9, lines 2-36, Fig.7)

12. *James, Jr.* teaches determining if a floppy disk is present in floppy drive of the information apparatus. If the floppy disk is present the information apparatus boots from the floppy disk, if the floppy disk is not present the information apparatus boots from ROM, 78. The floppy disk contain a ROM startup image program and obviously has a data storage area. It is well known in the art that a floppy disk is accessed via a file allocation table, which maps the files that are stored on the floppy disk.

13. As per claims 27 and 37 *James, Jr.* teaches an information processing apparatus (computer) comprising:

- a processor (32, Fig. 1) for executing a booting program to start up said information apparatus (Fig.1); and
- a communication unit for data communication with a plurality of data stored for storing data, at least one of said data stores being removably (Floppy Disk, 74, Fig.1) connected to said information processing apparatus;
- wherein said processor selectively uses said data stored in said plurality of data according to said booting program to start up said information processing apparatus;



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- whereby said other data store (floppy disk, 74) comprises a file allocation table block operable to store header information, a startup image display program storage block operable to act as a read only memory, and a data block operable to store data generated by said information processing apparatus. (col. 9, lines 2-36, see paragraph 12)

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tammara Peyton whose telephone number is (703) 306-5508. The examiner can normally be reached between 6:30 - 4:00 from Monday to Thursday, (I am off every first Friday), and 6:30-3:00 every second Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin, can be reached on (703) 308-3301. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3718. Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Mailed responses to this action should be sent to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231.

Faxes for Official/formal communications intended for entry should be sent to:

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(703) 746-7238, After Final (703) 746-7239

or, for informal or draft communications, to:

(703) 746-7240 (please label "PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to:

Crystal Park II, 2121 Crystal Drive, Arlington, VA, Fourth Floor

(Receptionist).

A handwritten signature in black ink, appearing to read 'Tammara Peyton', with a stylized, flowing script.

Tammara Peyton

May 12, 2003